



ATTORNEY'S DOCKET NUMBER: 0492611-0364 (MIT 8616)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Ameer *et al.*

Examiner: Webman, E. J.

Serial No.: 09/495,278

Art Unit: 1616

Filing Date: January 31, 2000

Title: TRANSDERMAL THERMAL POLYMERIZATION

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPLICATION FOR PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. § 1.705(b)

A Notice of Allowance was mailed November 21, 2005 in the above-referenced case along with a Determination of Patent Term Extension under 35 U.S.C. § 154(b). The Determination of Patent Term Extension indicates 0 days of patent term extension for the patent to grant from the present Application. Applicant hereby request reconsideration of the patent term adjustment indicated and respectfully submits that the Applicant is entitled to 444 days of patent term extension as outlined below. A Credit Card Payment Form authorizing payment in the amount of \$200.00 to cover the fee set forth in 37 C.F.R. § 1.18(e) is enclosed.

Statements of the Facts under 37 C.F.R. § 1.705(b)(2)

Applicant respectfully submits that the correct patent term adjustment for the above-referenced application is 444 days in accordance with 37 C.F.R. §§ 1.702-1.704. That is, 589 days due to Office delays less 145 days due to Applicant delays. The above-referenced Application is not subject to a Terminal Disclaimer.

USPTO delay under 37 C.F.R. § 1.702

The Patent Term Adjustment History (attached hereto as **Exhibit A**) indicates that the present application is entitled to 0 days of patent term adjustment due to delays on the part of the United States Patent and Trademark Office ("Office"). Applicant disagrees with this finding.

02/22/2006 JBALINA2 00000055 09495278

02 FC:1455

200.00 OP

Instead, Applicant submits that the period of adjustment under 37 C.F.R. § 1.702 is 589 days.

Under 37 C.F.R. § 1.702(a)(1), Applicant is entitled to an extension of patent term corresponding to the number of days in the period beginning on the day after the date that is fourteen months after the filing date and ending on the date of mailing of an action under 35 U.S.C. § 132, or a Notice of Allowance under 35 U.S.C. § 151.

The first delay of the Office in this case runs from April 1, 2001, which is the day after the date that is fourteen months after the filing date of January 31, 2000, to June 4, 2001, the mailing date of the first Restriction Requirement issued by the Office. This delay under 37 C.F.R. § 1.702(a)(1) totals 65 days.

The second Office delay runs from March 2, 2002, which is the day after the date that is four months after the Response to the Restriction Requirement (mailed October 1, 2001) was filed, to May 27, 2002, the mailing date of the first Office Action issued by the Office. This delay under 37 C.F.R. § 1.702(a)(2) totals 25 days.

The third Office delay runs from April 7, 2003, which is the day after the date that is four months after the Response to the Office Action (mailed June 6, 2002) was filed, to April 16, 2003, the mailing date of the second Office Action issued by the Office. This delay under 37 C.F.R. § 1.702(a)(2) totals 9 days.

Finally, the fourth Office delay runs from July 19, 2004, which is the day after the date that is four months after the Response to the Office Action (mailed October 22, 2003) was mailed, to the November 21, 2005, the mailing date of the Notice of Allowance. This delay under 37 C.F.R. § 1.702(a)(2) totals 490 days.

The total period of adjustment under 37 C.F.R. § 1.702 for Office delays is 589 days.

Applicant delay under 37 C.F.R. § 1.704

The Patent Term Adjustment History (attached hereto as **Exhibit A**) also indicates that the patent term adjustment due to Office delay should be reduced by 0 days due to Applicant delay. Applicant disagrees with this finding as well and respectfully submits that the 589 days of patent term adjustment as calculated above should be reduced by 145 days.

Under 37 C.F.R. § 1.704(a), “[t]he period of adjustment of the term of a patent under §§ 1.703(a) through (e) shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution (processing or

examination) or the application.” Under 37 C.F.R. § 1.704(b), an Applicant is deemed to have failed to engage in reasonable efforts to conclude prosecution of an application for the cumulative total of any periods of time in excess of three months taken to respond to an outstanding Office Action. Under 37 C.F.R. § 1.704(b), any shortened statutory period for reply that is set out in an Office Action or Notice has no effect on the three-month period for reply as utilized in determining patent term adjustment.

Specifically, in responding to the Office Action mailed June 6, 2002, Applicant took an additional three months from September 7, 2002, to December 6, 2002, to respond to the outstanding Office Action. This Applicant delay under 37 C.F.R. § 1.702(b) totals 91 days.

In addition, Applicant delayed in responding to the Office Action mailed October 22, 2003. The day after the date that is three months after the date of mailing the Office Action was January 23, 2004. Applicant did not file a Response until March 18, 2004, resulting in an Applicant delay under 37 C.F.R. § 1.702(b) of 54 days.

Thus, the total period of adjustment under 37 C.F.R. § 1.704 for the above Applicant delays is 145 days.

Conclusion

Applicant submits that this application for patent term adjustment is timely since it is being submitted with payment of the issue fee. 37 C.F.R. § 1.705(b). Applicant requests that the patent indicate the revised patent term adjustment of 444 days.

Respectfully submitted,



C. Hunter Baker, M.D., Ph.D.
Registration Number 46,533

Choate, Hall & Stewart LLP
Two International Place
Boston, MA 02110
t (617) 248-5000
f (617) 248-4000
chb@choate.com
Date: February 16, 2006

Certificate of Mailing

I certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to Mail Stop Issue Fee, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

February 16, 2006
Date



Heather A. Mariacher
Signature

Typed or Printed Name of person signing certificate



Exhibit A



United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [FAQ](#) | [Glossary](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [PAIR](#) | [Alerts](#) | [News](#) | [Help](#)
**PATENT APPLICATION INFORMATION RETRIEVAL**

PAIR
FAQ
Help
Feedback

 [Printer Friendly Version](#)
Patent Term Extension (PTE) for application number: 09/495,278

Explanation of Calculations		Days
Filing or 371(c) Date:	01-31-2000	USPTO Delay (PTO): 0
USPTO Adjustment (days):	+0	Corrections (APPL): 0
		Total PTE: 0

Other Links

E-Business Center Patents
Employee Locator
Class/Subclass GAU Information
Information Contacts

Select Search Option

[Assignments](#)
[Continuity Data](#)
[File History](#)
[Image File Wrapper](#)
[Publication Review](#)
Search**Patent Term Extension History**

Date	Contents Description	PTO (days)	APPL (days)
11-21-2005	Mail Notice of Allowance		
11-21-2005	Mail Formal Drawings Required		
10-06-2005	Correspondence Address Change		
10-04-2005	Formal Drawings Required		
10-04-2005	Notice of Allowance Data Verification Completed		
10-04-2005	Case Docketed to Examiner in GAU		
10-04-2005	IFW TSS Processing by Tech Center Complete		
04-05-2005	Case Docketed to Examiner in GAU		
02-17-2005	Miscellaneous Incoming Letter		
04-14-2004	Date Forwarded to Examiner		
03-22-2004	Response after Non-Final Action		
03-22-2004	Request for Extension of Time - Granted		
10-22-2003	Mail Non-Final Rejection		
10-01-2003	Non-Final Rejection		
07-24-2003	Date Forwarded to Examiner		
07-11-2003	Response after Non-Final Action		
04-16-2003	Mail Non-Final Rejection		
03-24-2003	Non-Final Rejection		
01-09-2003	Date Forwarded to Examiner		
12-11-2002	Response after Non-Final Action		
12-11-2002	Request for Extension of Time - Granted		
10-14-2002	Case Docketed to Examiner in GAU		
06-06-2002	Mail Non-Final Rejection		
06-05-2002	Non-Final Rejection		
05-14-2002	Date Forwarded to Examiner		

05-06-2002	Response to Election / Restriction Filed
03-27-2002	Mail Restriction Requirement
03-25-2002	Requirement for Restriction / Election
01-29-2002	Case Docketed to Examiner in GAU
01-23-2002	X-Pre-Legal Complete Amended Case
01-23-2002	Date Forwarded to Examiner
01-17-2002	Response to Election / Restriction Filed
10-01-2001	Mail Restriction Requirement
09-28-2001	Requirement for Restriction / Election
09-27-2001	Case Docketed to Examiner in GAU
07-23-2001	Information Disclosure Statement (IDS) Filed
07-11-2001	Date Forwarded to Examiner
07-05-2001	Response to Election / Restriction Filed
06-04-2001	Mail Restriction Requirement
06-01-2001	Requirement for Restriction / Election
05-07-2001	Case Docketed to Examiner in GAU
07-21-2000	Information Disclosure Statement (IDS) Filed
05-22-2000	Case Docketed to Examiner in GAU
05-17-2000	Application Dispatched from OIPE
05-17-2000	Application Is Now Complete
04-03-2000	Notice Mailed--Application Incomplete--Filing Date Assigned
04-03-2000	Correspondence Address Change
02-28-2000	IFW Scan & PACR Auto Security Review
02-07-2000	Preexamination Location Change
02-07-2000	Initial Exam Team nn
06-12-2001	Dummy Standard Action - DO Not DELETE

[.HOME](#) | [INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [CONTACT US](#) | [PRIVACY STATEMENT](#)